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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,888	07/08/2003	Terence Gerard Daly	10407-631	9852

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EXAMINER	
BROCKETTI, JULIE K	

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/615,888	DALY, TERENCE GERARD	
	Examiner	Art Unit	
	Julie K. Brocketti	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 December 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 15, 2005 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the fourth paragraph of 35 U.S.C. 112:

> A claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed.

Claims 2, 17 are rejected under 35 U.S.C. 112, fourth paragraph for failing to limit the subject matter of a previous claim.

Claim 2 states "stopping the spinning of the selected reels, after the consolidating of the reels within the display window." Claim 1 as amended now states "consolidating the selected reels within the display window; and stopping the subset of the currently spinning reels ..." Applicant has clearly recited in his remarks that the independent claims have an ordered method, therefore, claim 2 is not further limiting the subject matter that is recited in claim 1.

Claim 17 states "stopping the spinning of the selected reels, after the rearranging of the selected reels adjacent to one another." Claim 16 as amended now states, "rearranging the selected reels adjacent to one another; and stopping the subset of the currently spinning reels..." Applicant has clearly recited in his remarks that the independent claims have an ordered method, therefore, claim 17 is not further limiting the subject matter that is recited in claim 16.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-8, 10-12, 15-23, 25-27, 30 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Munoz, U.S. Patent Application Publication No. 2004/024313 A1 in view of Singer et al., U.S. Patent No. 6,604,740 B1. Munoz discloses a gaming method for playing a reel selection slot machine. A plurality of reels within a display window are spun. The plurality of reels each display one or more game symbols (See Munoz Fig. 3). A subset of the reels is selected for use in determining a game outcome. The non-selected reels are removed from a player's view within the display reel.

The selected reels are consolidated in the display window so as to be rearranged so that the selected reels are adjacent to one another. It is then determined if the selected reels produce a winning game outcome and a prize is awarded if a winning game outcome is achieved (See Munoz Fig. 4; ¶0022, ¶0028-¶0030) [claims 1, 16, 30]. The spinning of the reels are stopped after the consolidating of the selected reels within the display window (See Munoz ¶0004, ¶0028) [claims 1, 2, 16, 17, 31]. The consolidating of the selected reels within the display window includes juxtapositioning the selected reels to eliminate any non-contiguous positioning of the selected reels produced by the removal of the non-selected reels (See Munoz Figs. 4-6) [claims 5, 20, 30]. The selection of the subset of reels for use in determining a game outcome is player controlled (See Munoz ¶0028) [claims 6, 21]. The selection of the subset of reels for use in determining a game outcome is computer controlled (See Munoz ¶0031) [claims 7, 22]. The plurality of reels are video representations of physical reels (See Fig 3) [claims 8, 23]. The gaming method is used as a bonus game in conjunction with an underlying primary game (See Munoz ¶0033) [claims 10, 25]. A winning outcome in the bonus game results in a prize that is added to a prize won in the underlying primary game or a multiplying prize won in the underlying primary game (See Munoz ¶0005) [claims 11, 12, 26, 27]. For example, if a player gets a 2 x multiplier, this "doubles" the primary prize, i.e. it adds the primary prize to itself. The gaming method may be used as a primary game (See Munoz ¶0004) [claims 15, 30].

Munoz discloses stopping the spinning of the reels after consolidating the selected reels within the display window. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to stop the spinning of the selected reels before consolidating the selected reels or before removing the non-selected reels from a player's view within the display window because Applicant has not disclosed that the time the reels are stopped provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Munoz's gaming device and applicant's invention to perform equally well with stopping the spinning of the reels at any time because no matter when the reels are stopped, the player still gets to view the game outcome. Therefore, it would have been prima facie obvious to modify Munoz to obtain the invention as specified in claims 3, 4, 18 and 19 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Munoz.

Munoz lacks in disclosing selecting a subset of the reels while they are currently spinning. Singer et al. teaches of a slot machine in which a player may select paylines or an amount bet per line before or after the reels of a slot machine are spinning (See Singer col. 8 lines 17-20). Consequently, whether a player selects elements, i.e. paylines, amount bet per line, or reels to form an outcome, before or after the reels of a slot machine are spun is also an obvious design choice. At the time the invention was made, it would have been an

obvious matter of design choice to a person of ordinary skill in the art to select a subset of symbols while they are currently spinning because Applicant has not disclosed that selection of currently spinning reels provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with selection of non-spinning reels because the selection of the reels that make up the game outcome are still selected before the outcome is determined. Therefore, just as Singer teaches that a player may select certain elements either before or after the reels are spinning, it would be obvious to one of ordinary skill in the art to select a subset of reels of Munoz as the reels are currently spinning because the outcome of the game still has not been determined when the selection is made.

Claims 9 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munoz in view of Singer in further view of the Price is Right game "Squeeze Play". Munoz lacks in disclosing randomly changing the position of the selected reels after removing the non-selected reels. In the Price is Right game "Squeeze Play" a contestant, randomly chooses one number out of three numbers to be removed from the price of a prize. Once that number is removed, the remaining numbers randomly change positions, i.e. based on the contestant's random selection of the removed number, and the remaining numbers remain and are compared to the price of the prize and it is determined if the contestant wins (See "Squeeze Play") [claims 9, 24]. It would

have been obvious to one of ordinary skill in the art at the time the invention was made to randomly change the position of the selected reels after removing the non-selected reels in the game of Munoz. By changing the reel positions, the player can clearly see which reels are still involved in the play of the game and can concentrate on these reels instead of reels not involved in the game outcome.

Claims 13, 14, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munoz in view of Singer in further view of Fier, U.S. Patent No. 6,126,542. Munoz lacks in disclosing that the bonus game reduces or loses a prize in the underlying primary game. Fier teaches of a gaming device and describes in the background of the invention how it is common throughout the art that when a non-winning game outcome occurs in the bonus game, there is the possibility of losing or reducing a prize won in the underlying primary game (See Fier 2 lines 16-26) [claims 13, 14, 28, 29]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the player risk their primary game award when in order to play the bonus game. By having the player risk their primary award, the casino can recoup the primary award if the player loses the bonus game. Therefore, by having the player risk their primary award the casino can make money in order to pay off the bonus games with winning outcomes.

Response to Amendment

It has been noted that claims 1, 16 and 31 have been amended.

Response to Arguments

Applicant's arguments filed December 15, 2005 have been fully considered but they are not persuasive.

The Examiner notes that Munoz does not have a player select a subset of "currently" spinning reels as now claimed, therefore, the 102 rejection has been withdrawn but a 103 rejection has been made.

It is noted that Applicant clearly states that the order of the method steps is relevant and that the claims should be read having a first step of spinning the reels, followed by selecting a subset of the currently spinning reels. The Examiner notes that reading the claims in this specified manner, Applicant's invention is still obvious in view of Munoz and Singer.

Applicant argues that there is no "design choice" standard under 35 USC 103. The Examiner disagrees. To support a conclusion that a claim is directed to obvious subject matter, prior art references must suggest expressly or impliedly the claimed invention or an Examiner must present "convincing line of reasoning" as to why one of ordinary skill in the art would have found the claimed invention to have been obvious. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). In doing so, the Examiner may rely on "logic or scientific principle." In re Soli, 317 F.2d 941, 947, 137 USPQ 797, 801 (CCPA 1963). In this case, the reference Singer clearly teaches that whether a person

selects certain elements before or while reels of a slot machine are spinning does not matter since the outcome of the game has yet to be determined. Munoz clearly teaches selecting a subset of reels and consolidating those reels for game play. To have the reels currently spinning when the selection is made would be obvious since no effect on the underlying game occurs whether or not the subset of reels occur prior to or during the spinning of the reels.

Applicant further argues that Munoz does not disclose consolidating the reels. The Examiner disagrees and notes that Munoz discloses 5 reels in which 2 may be inactive and are removed from play by a variety of methods. Therefore, the gaming machine can then have only 3 reels, which have been consolidated from 5 reels.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K. Brocketti whose telephone number is 571-272-4432. The examiner can normally be reached on M-Th 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Julie K Brocketti
Primary Examiner
Art Unit 3713